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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,237	06/26/2003	Yoshiaki Suzuki	01272.020589	4242
5514	7590	08/28/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EDWARDS, LAURA ESTELLE	
			ART UNIT	PAPER NUMBER

1734

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/606,237

Applicant(s)

SUZUKI ET AL.

Examiner

Laura Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-13,15,16,50 and 51 is/are pending in the application.
4a) Of the above claim(s) 50 and 51 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3-13,15 and 16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

Applicant's election with traverse of Group I, claims 1, 3-13, 15, and 16 in the reply filed on 4/19/06 is acknowledged. The traversal is on the ground(s) that the apparatus and method claims should be searched together because the same search (duplicative search) would be required for the apparatus and the method claims such that no undue burden would be placed on the Examiner. This is not found persuasive because the apparatus claims require one search and the method claims another search as noted in the restriction requirement such that an undue burden would be placed on the Examiner already substantially limited in examination time.

The requirement is still deemed reasonable, proper, and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 9, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lakes (US 4,226,886).

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Lakes teaches a liquid transfer device comprising a liquid transfer member (74) having a transfer surface, the liquid transfer member including a liquid accumulating portion (24) accumulating the liquid; and a restricting portion (22) formed from a porous film formed with fine pores, supplying the liquid in said liquid accumulating portion to said transfer surface with restriction, the porous film having a thickness (i.e., depth) 10 to 200 microns (col. 5, lines 3-11) and pore diameter range of 0.1 to 3 microns (col. 3, lines 16-27 and col. 4, lines 50-56) wherein the liquid in the liquid accumulating portion is supplied to the printed product through the porous film by a depression force (see for example, Fig. 7).

With respect to a holding member, the liquid transfer member can be mounted on a shaft or rod to form a roller as shown in Fig. 5.

With respect to claim 9, this claim has been given no patentable weight because the established relationship, between the accumulating portion, film, and product intended to be used with the apparatus, does not constitute a structural limitation.

With respect to claim 15, the liquid transfer member is construed to be a multilayered deformable film or sheet product that when placed on a shaft or rod to contact another surface can take the form of said surface even when said another surface is curved.

Claims 1, 3, 9, and 15 are rejected under 35 U.S.C. 102(a) and/or (e) as being anticipated by Suzuki et al (US 2003/0024474).

Suzuki et al teach a liquid transfer device comprising a liquid transfer member or covered roll (201) having a transfer surface contacting an ink printed surface, the liquid transfer member including a liquid accumulating portion (212) accumulating the liquid; and a restricting portion

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(211) formed from a porous film formed with fine pores, supplying the liquid in said liquid accumulating portion to said transfer surface with restriction, the porous film having a thickness 10 to 200 microns and pore diameter range of 0.1 to 3 microns wherein the liquid in the liquid accumulating portion is supplied to the printed product through the porous film by a depression force (see Fig. 10; [0091, 0092, 0098]).

With respect to a holding member for receiving and holding the liquid transfer member, see structural body (213).

With respect to claim 9, this claim has been given no patentable weight because the established relationship between the accumulating portion, film, and printed product intended to be used with the apparatus do not constitute a structural limitation.

With respect to claim 15, the liquid transfer member is construed to be a film or sheet that is formed over the accumulating portion as evidenced by [0089-0092].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3, 5, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes (US 4,226,886) in view of Lofgren (US 3,326,180).

The teachings of Lakes have been mentioned above but Lakes fails to teach or suggest the holding member being in the form of a receptacle member with a surface supporting frame. However, it was known in the art, at the time the invention was made, to contain a multilayered pad product in a receptacle member for holding the supply fluid with a surface supporting frame or edge around the receptacle member in order to dispense or meter the supply fluid therefrom as evidenced by Lofgren (see Fig. 1, col. 2, lines 8-28). It would have been obvious to one of ordinary skill in the art to provide a holding member as taught by Lofgren to enclose or encase the liquid transfer member of Lakes so as to dispense or meter the supply fluid to another surface such in the use the of the transfer member as a self metering pad.

Claims 4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes (US 4,226,886).

The teachings of Lakes have been mentioned above but Lakes is silent concerning the uniformity in density of the liquid accumulating portion. However, because Lakes illustrates the liquid accumulating portion being formed from a polymeric composition compressed into a sheet or layer of uniform thickness (See Fig. 2; col. 7, lines 38-43), one of ordinary skill in the art would expect that the liquid accumulating portion or layer to be of a uniform density.

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Alternatively, because Lakes recognizes that the polymeric composition can be extruded as two or more layers with different void volumes or channels (see col. 7, lines 13-17), one of ordinary skill in the art would readily appreciate that the liquid accumulating portion resulting from a multilayered sheet of different void volumes and or channel sizes to result in a sheet having different or varying density in thickness direction thereof.

Claims 8, 10, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes (US 4,226,886) in view of Terry (US 5,213,751).

The teachings of Lakes have been mentioned above but Lakes fails to teach or suggest the liquid accumulating portion being formed of laminated sheets of different densities. However, it was known in the art, at the time the invention was made, to form a multilayered pad product including a liquid accumulating portion via the lamination of sheets of different materials (including polymer and adhesive) as evidenced by Terry (col. 3, lines 28 to col. 4, line 23). In light of the teachings of Terry, one of ordinary skill in the art would readily appreciate the liquid accumulating portion of Lakes to be alternatively formed from lamination of at least one polymeric sheet layer adjacent an adhesive layer to result in a multilayered sheet of different materials and therefore different densities.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lakes (US 4,226,886) in view of Kent (US 3,009,440).

The teachings of Lakes have been mentioned above but Lakes fails to teach or suggest the liquid accumulating portion having stripe form grooves on a bottom surface thereof.

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However, it was known in the art, at the time the invention was made, to form a multilayered pad product including a liquid accumulating portion having stripe form grooves on a bottom surface thereof to allow for penetration of fluid into the pad product as evidenced by Kent (col. 2, lines 13-19). It would have been obvious to one of ordinary skill in the art to provide grooves as taught by Kent on the bottom surface of the liquid accumulating portion of Lakes in order to facilitate penetration of fluid into the pad product.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Laura Edwards
Primary Examiner
Art Unit 1734

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August 21, 2006